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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP			BLAIR, DOUGLAS B	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/017,728	<b>Applicant(s)</b> AUERBACH ET AL.
	<b>Examiner</b> DOUGLAS B. BLAIR	<b>Art Unit</b> 2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 26 December 2007.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 8-14 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 8-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The applicant has amended claims 8, 11, and 13.

### ***Response to Arguments***

Applicant's arguments filed 9/6/2007 and supplemental remarks filed on 12/26/2007 have been fully considered but they are not persuasive.

### **Specification Objections**

On page 5 of the 9/6/2007 response the applicant argues that the specification provide antecedent basis for the term substantially empty used in claim 10. The applicant first states:

Notwithstanding, Applicants note that the Appellants' disclosure includes several discussions of a substantially empty message and empty message.

If the applicant's disclosure "includes several discussions of a substantially empty message and empty messages", then it should not be hard to specifically point out one of these "several discussions". The objection would not be set forth if it was believed that the applicant's disclosure included examples so merely saying that there are numerous examples without pointing out any does nothing to further prosecution.

The applicant then goes on to state:

Moreover, the phrase "substantially empty message" is self-defining. For example, one would not be required to explain the term "substantially empty bucket." An empty bucket is empty, and a substantially empty bucket is empty but not necessarily to the nth degree. Similarly, an empty message does not contain any information, but it not necessarily absent information to the nth degree. Therefore, Applicants respectfully solicit withdrawal of the imposed objection to the specification.

This rationale ignores the actual claim which is directed towards "creating a substantially empty message". If the message is being created then why would it "not necessarily absent

information to the nth degree"? In other words, if the applicant's invention creates the message then it should be in control of the content of the message. The applicant's specification provides no description of a "substantially empty" message nor does the applicant provide any explanation of what "information of the nth degree" may compromise in terms of the applicant's claims. It is unclear what a substantially empty message is and thus the specification is still objected to.

In the arguments filed on 12/26/2007 the applicant argues that the phrase temporary storage is found throughout the specification. In response, the Examiner agrees but as stated in the objection, **there is no description of temporary storage provided**. In response to the applicant's statement that they are unclear as to why the Examiner believes that he Applicant's specification does not describe "temporary storage", the Examiner points out that the applicant argued that the previous office actions do not show "temporary storage" in the Appeal Brief filed on 1/24/2007 (See pages 11-12). The objection was made in order to clarify the record as to what the applicant regards as "temporary storage". The applicant has still not explicitly explained what is meant by "temporary storage" so the objection is maintained.

#### **112 2nd paragraph rejections**

The applicant's amendments have overcome the 112 2nd paragraph rejections.

#### **102 rejections based on Herz**

The applicant first argues that Herz does not teach attributes in a subscription request on the paragraph spanning from pages 6-7. In response the Examiner points out that the applicant's specification provides no limiting definition of the "attributes" or a "subscription request" so the interpretation and explanation provided in the rejection is proper given the broad claim language used by the applicant. The applicant has not provided any explanation of what a subscription

request is and how the request for publications of interest taught by Herz cannot be considered a subscription request.

Next the applicant argues that "the Examiner has not considered the entirety of Applicants' disclosure" and cites the paragraph spanning pages 5 and 6 of the applicant's disclosure. In response, the Examiner sees nothing more than an incomplete example at best provided by this paragraph. The paragraph in question does nothing to limit the terms "first filter expression type" nor has the applicant provided any explanation of how the paragraph does provide support.

On page 8 of the applicant's response the applicants note, " that the Examiner has still failed to establish that Herz explicitly teach all of the claimed invention. Much of the Examiner's analysis relies on unstated claim construction and unstated analysis to which the Applicant's are not privy". In response to this statement, the Examiner points out that the rejections provide explicit mappings about how the Examiner is interpreting every limitation and if the applicant had trouble understanding this interpretation, the applicant could have called the Examiner at the number indicated in each Office Action mailed in this application. In fact the Examiner invited the applicant to call the Examiner if the applicant wanted the rejections explained in the Office action mailed on 8/23/2006. No such call was ever made to the Examiner.

On page 9 of the applicant's remarks the applicant argues that, "Notwithstanding the Examiner's assertion that a profile includes attributes, the mapping of a profile is not necessarily comparable to the mapping of an attribute." The applicant provides no further explanation so the Examiner maintains the position in question because the rejection would not have been set forth if it was believed by the Examiner that Herz reads on the limitations in question.

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With respect to the dependent claims the applicant is again arguing that the Examiner has not fully shared the reasons for rejecting the claims. The Examiner disagrees because the Examiner feels that the claims are explicitly mapped and again points out that the applicant never called for clarification but instead chose to complain that the, "Applicants are not in position to guess/speculate as to the reasons why an Examiner is rejecting a particular claim or as to the claim construction that the Examiner is employing to reject a particular claim." The Examiner has established a *prima facie* case of anticipation and the Examiner is not responsible for the applicant's representatives seeming inability to comprehend the rejections presented.

The applicant concludes that:

Notwithstanding the previous-presented comments, Applicants note that the claims have been amended to clarify that the first type is first filter expression format type and the second type is a second filter expression format type and that the first filter expression format type is different than the second filter expression format type. As previously noted above, the type refers to the formatting of the filter expressions within the request or publication message. The Examiner's cited reference of Herz, however, is silent as to the formatting of filter expressions within the alleged request (i.e., profile) and the alleged publication message (i.e., news article). Thus, for the reasons stated above, Applicants submit that the imposed rejection of claims 8-9 and 11-14 under 35 U.S.C. § 102 for anticipation based upon Herz is not factually viable. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claims 8-9 and 11-14 under 35 U.S.C. § 102 for anticipation based upon Herz.

In response the Examiner points out that the newly amended claim limitations have no limiting definition within the applicant's specification and are therefore interpreted broadly. There is no discussion of what a first filter expression format type comprises nor is there any discussion of what a second filter expression format type comprises. Therefore the profile and new article are considered to have some form of "filter expression format" and clearly the profile and the article taught by Herz are different.

**102 rejections based on Jannu**

First the applicant argues that the Examiner has not even alleged that Jannu teaches the limitation of "mapping at least a part of the at least one attribute to a generic format". The Examiner disagrees. It would be apparent to anyone reading the disclosure provided by Jannu that subscription messages are received in multiple formats (mainframe, JMS, CORBA etc.). The various formats are mapped to a structured event as explained in the cited portion of Jannu (col. 6, lines 58-64). The mapping makes it clear that this is how the claim is interpreted and thus a *prima facie* case of anticipation was established.

The applicant then argues that Jannu does not teach the amended first filter expression format type and the second filter expression format filter type. Given the non-limiting definitions provided by the applicant of these terms, the subscribe and publish messages taught by Jannu read on these limitations.

Finally the applicant directed the Examiner to the statement found in MPEP section 706(II). In response, the Examiner appreciates the applicant's advice in patent examining and the Examiner's acknowledges the responsibility to offer definite suggestions for correction in order to identify patentable subject matter, however the applicant's specification is void of detail that would overcome the prior art of record and thus no suggestions can be made.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the applicant's specification does not describe how a message can be "substantially empty" as claimed in claim 10. The term "substantially empty" appears to be a

contradiction. The applicant's specification does not describe "temporary storage" as claimed in claim 14.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-9 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent Number 6,460,036 to Herz.

As to claim 8, Herz teaches a method for receiving publications and forwarding said publications on to parties who have subscribed to receive such publications, said method comprising:

receiving a subscription request of a first filter expression format type, said request including a filter expression having at least one attribute (**col. 4, line 49-col. 5, line 7, the search profile or query contains keywords and target objects to request publications of interest, col. 56, lines 21-25 show search profiles containing keywords and attributes that are filter expressions;**).

mapping at least a part of the at least one attribute to a generic format (**col. 57, lines 39-51, the search profiles are mapped to generic cluster profiles;**).

receiving a publication message of a second filter expression format type (**col. 4, lines 49-col. 5, line 22, the article which is used to create a target profile, col. 57, lines 20-29, the news articles, having target profiles, are clearly not the same “type” as the search profiles;**)

comparing a publication message received the subscription request to determine whether to format the publication message to a subscriber originating the request (**col. 57, lines 8-36, the search profile is compared with the target profile**), the comparing comprising:

identifying a generic format filter attribute (**cols. 57, lines 39-51, the cluster profile is a generic filter contains generic filter attributes**);

mapping the generic format filter attribute to a format corresponding to the second filter expression format type (**col. 57, line 39-51, the clustered search profiles are mapped to the target objects**), the method further comprising:

transmitting said publication message to the originating subscriber (**col. 58, lines 28-31, the list of articles is presented to the user.**), wherein the first filter expression format type is different than the second filter expression format type (**the search profile is clearly different from the article**).

As to claim 9, Herz teaches the communications manager of claim 8, further comprising preparing the publication message for transmission to said originating subscriber (**col. 58, lines 25-54, the list of articles are prepared for the user.**).

As to claim 11, Herz teaches the communications manager of claim 8, 9, or 10, wherein the mapping at least part of an attribute to a generic format comprises: invoking a first component capable of understanding messages of said first filter expression format type (**col. 57, lines 8-51, the search profiles are analyzed as described above**).

As to claim 12, Herz teaches the communications manager claims 8, 9, or 10 comprising:  
storing said generic format filter attribute (**col. 56, line 49-col. 57, line 5**).

As to claim 13, Herz teaches the communications manager of any preceding claim,  
wherein said mapping a generic format filter attribute to a format corresponding to the second  
filter expression format type comprises: invoking a second component capable understanding  
messages of said second type (**the target profiles are analyzed as described above**).

As to claim 14, Herz teaches the communications manager of any preceding claim,  
wherein said format corresponding to the second message type is held in temporary storage until  
said comparison is complete (**col. 56, line 49-col. 57, line 5**).

Claims 8-14 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number  
7,216,181 to Jannu et al.

As to claim 8, Jannu teaches a method for receiving publications and forwarding said  
publication on to parties who have subscribed to receive such publications, said method  
comprising: receiving a subscription request (**col. 6, lines 9-11**) of a first filter expression format  
type (**col. 6, lines 6-9, the “first” type could be a mainframe, CORBA, or JMS message**),  
said request including a filter expression having at least one attribute (**col. 6, lines 16-22, the  
information which registers the interest is considered the filter expression with an  
attribute**); mapping at least part of the at least one attribute to a generic format (**col. 6, lines 58-  
64**); receiving a publication message (**col. 6, line 18**) of a second filter expression format type  
(**col. 6, lines 6-9, the “second” type could be a mainframe, CORBA, or JMS message**);  
comparing the publication message received to the subscription request to determine whether to  
forward the publication message to a subscriber originating the request (**col. 6, lines 16-22**), the

comparing comprising: identifying a generic format filter attribute (**col. 6, lines 58-64, the structured event format**); and mapping the generic format filter attribute to a format corresponding to the second filter expression format type (**col. 6, lines 58-64**), the method further comprising: transmitting said publication message to the originating subscriber (**col. 6, lines 21-22**), wherein the first filter expression format type is different than the second filter expression format type (**the publish and subscribe messages are clearly of different "types"**).

As to claim 9, Jannu teaches the method of claim 8, further comprising: preparing the publication message for transmission to said originating subscriber (**col. 6, lines 32-46**).

As to claim 10, Jannu teaches the method of claim 9, wherein the step of preparing the publication message for transmission to said originating subscriber comprises: creating a substantially empty message of said first filter expression format type (**col. 6, lines 35-46**); extracting information from the publication message of said second filter expression format type (**col. 6, lines 16-22**); and inputting said information into said substantially empty message (**col. 6, lines 16-22**).

As to claim 11, Jannu teaches the method of claim 10, wherein mapping at least part of an attribute to a generic format comprises: invoking a first component capable of understanding message of said first filter expression format type (**The adapters shown in Figure 3**).

As to claim 12, Jannu teaches the method of claim 10, comprising: storing said generic format filter attribute (**col. 6, lines 58-64**).

As to claim 13, Jannu teaches the method of claim 10, wherein mapping a generic format filter attribute to a format corresponding to the second filter expression format type comprises:

invoking a second component capable of understanding messages of said second filter expression format type (**The adapters shown in Figure 3**).

As to claim 14, Jannu teaches the method of claim 10, wherein said format corresponding to the second message type is held in temporary storage until said comparing is complete (**col. 6, lines 58-64, the brokering server has RAM and is able to locate the adapters of the “second type”**).

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/  
Examiner, Art Unit 2142